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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,713	12/21/2001	George Gillespie	092259-9008-00	5813

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WILLIAM B. PATTERSON
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 POST OAK BLVD.
SUITE 1500
HOUSTON, TX 77056

EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,713

Applicant(s)

GILLESPIE ET AL.

Examiner

Jennifer H Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 17-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,17-19,23,28,29 and 35 is/are allowed.
- 6) ☒ Claim(s) 20-22,24-27,30-32,34 and 36 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 22, 24, 25, 30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Geske (US 4,096,911).

Regarding claim 30: Geske discloses a well screen cover that includes the following features:

- A tube (18) having a plurality of perforations disposed therethrough.
- A preformed channel (14) coupled to the tube and disposed along the length of the tube.

Regarding claim 22: Geske does not specifically disclose that press breaking the channel along the length of the perforated tube forms the channel. However, the method of forming the device is not germane to the issue of patentability of the device itself.

Therefore, this limitation has not been given patentable weight.

Regarding claims 24 and 25: The channel defines sidewalls having upper portions that are welded to an inner surface of the perforated tube (see col. 4, lines 17-21).

Regarding claim 32: The tube is formed from a spirally wound strip of metal (see col. 3, lines 25 and 26).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3672

4. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geske (US 4,096,911).

As seen in Figure 8, the channel of Geske includes a floor and sidewalls. Geske does not disclose what material the channel and/or the perforated tube are made ^{from} ~~form~~. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the channel and/or perforated tube from either the same or different materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geske (US 4,096,911) in view of Bixenman (US 6,343,651).

Geske discloses all of the limitations of the above claims except for the well screen cover further including a support ring along the inner surface of the tube to support the channel and the tube.

Bixenman teaches a well screen similar to that of Geske. Bixenman further teaches a channel (152) coupled to a perforated tube (104). The screen also includes a support ring (42) along the inner surface of the tube where the ring supports the tube and the channel.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Geske to include a support ring as taught by Bixenman in order to have prevented the tube and channels from collapsing under the pressure of a wellbore.

6. Claims 31, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geske (US 4,096,911) in view of Lembcke et al. (US 6,173,788) and Bixenman (US 6,343,651).

Regarding claims 31 and 34: Geske discloses all of the limitations of the above claims except for using the channel to house fiber optic cable.

Lembcke et al. discloses a wellbore packer that includes a channel (14) formed on its outer surface. The channel is used to house control lines such as electrical cables,

Art Unit: 3672

hydraulic lines, fiber optic cables, etc. (see col. 1, lines 12-19). The examiner notes a channel used to house control lines in a wellbore packer to be equivalent to a wellbore screen with such a channel.

Bixenman teaches a well screen similar to that of Geske. Bixenman further teaches a channel (152) coupled to a perforated tube (104) where the channel is used to route control lines (hydraulic and electric) down the well screen.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the channel of Geske to house control lines as taught by Bixenman, specifically fiber optic cable as taught by Lembcke et al. in order to have provided a means for protecting the control lines. One would have been motivated to make such a combination because a means for preventing the control lines from becoming caught on other wellbore equipment would have been obtained.

The examiner further notes that since the Lembcke et al. recognizes the equivalence of the electric control lines used in Bixenman and the fiber optic cable taught in Lembcke et al. for their use in the wellbores and the selection of any of these known equivalents to control downhole equipment would be within the level of ordinary skill in the art.

Regarding claim 36: Geske discloses a method for completing a wellbore. The method involves providing a well screen cover in the wellbore where the cover includes a perforated tube (18) and a preformed channel (14) coupled to the tube and disposed along the length of the tube.

Geske discloses all of the limitations of the above claims except for using the channel to house fiber optic cable.

Lembcke et al. discloses a wellbore packer that includes a channel (14) formed on its outer surface. The channel is used to house control lines such as electrical cables, hydraulic lines, fiber optic cables, etc. (see col. 1, lines 12-19). The examiner notes a channel used to house control lines in a wellbore packer to be equivalent to a wellbore screen with such a channel.

Art Unit: 3672

Bixenman teaches a well screen similar to that of Geske. Bixenman further teaches a channel (152) coupled to a perforated tube (104) where the channel is used to route control lines (hydraulic and electric) down the well screen.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the channel of Geske to house control lines as taught by Bixenman, specifically fiber optic cable as taught by Lembcke et al. in order to have provided a means for protecting the control lines. One would have been motivated to make such a combination because a means for preventing the control lines from becoming caught on other wellbore equipment would have been obtained.

The examiner further notes that since the Lembcke et al. recognizes the equivalence of the electric control lines used in Bixenman and the fiber optic cable taught in Lembcke et al. for their use in the wellbores and the selection of any of these known equivalents to control downhole equipment would be within the level of ordinary skill in the art.

Allowable Subject Matter

7. Claims 4, 17-19, 23, 28, 29, and 35 are allowed.
8. Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The examiner notes that applicant has not argued the examiner's rejection of claims 20 and 21 as being merely a design choice. Therefore, it is assumed that applicant agrees that the material from which the channel and perforated tube are formed would be an obvious design choice.

Response to Arguments

10. In view of applicant's arguments regarding the objection to claim 4 and 28, that objection has been withdrawn.

Art Unit: 3672

11. Applicant's arguments with respect to claims 4 and 17-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

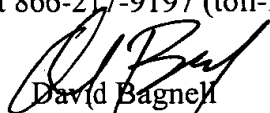
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

JHG 
February 9, 2004